

REMARKS/ARGUMENT

As a preliminary matter, the Examiner's attention is respectfully invited to the fact that claims 10-22 are still pending in this application. Applicant traversed the restriction requirement in the last response and provided reasons why the requirement should be withdrawn. The present Office Action does not indicate that the traversal was considered. Consideration of the traversal and withdrawal of the restriction requirement is respectfully solicited.

Claims 1-9 are rejected under 35 USC 103 over Shetty '449 in view of Akamatsu and the newly cited Onderkirk patent. This rejection is respectfully traversed.

The application acknowledges, at the top of page 4, that the Shetty patent shows a multilayer coextruded film. The Examiner is correct that the reference does not show that the multilayer structure has a thickness or width as set forth in the instant claims or that the film is a uniaxial oriented film. The Office Action avers that the thickness or width ranges or properties "which can be easily determined by one of ordinary skill in the art" and that "absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation." (pp. 2-3). In response, applicant respectfully submits that the fact that certain properties "can be easily determined" and that the "conditions of a composition" can be changed are not relevant. The statute (35 USC 103) deals with what is obvious, not merely theoretically possible, and therefore, there must be a reason or motivation to determine the ranges or to modify the conditions of a composition. There is no basis in the reference which permits one to even begin to conjecture that the proposed modifications constitute optimizing operating conditions nor is there motivation provided for making relevant changes. It is respectfully submitted that the assertions constitute, at best, a hindsight justification for making changes.

The Office Action acknowledges that Shetty does not show the ultimate tensile at break recited in instant claims 1 and 2. To overcome this deficiency, the Examiner has

relied on the Akamatsu reference and indicated that it (inadvertently referred to as “Shetty” in the Action) shows the tensile strength is about 6.7-7.2 kgf.

While the Office Action acknowledges applicant’s argument that Akamatsu does not show a multilayered structure, it states this is not persuasive “because such a tensile strength is optimizable.” (p. 4). It is respectfully submitted that this response has little, if anything, to do with applicant’s comment about a multilayered structure. There are very different considerations with regard to multilayer and monolayer structures. A multilayer structure is clearly subject to delamination of the layers making up the structure which, obviously, will effect tensile strength but this is not a consideration in a single layer film. The observation that a monolayer film may have “excellent mechanical properties” (p. 3) does not suggest a multilayer film will have such properties if a particular monolayer tensile strength is realized.

Moreover, selecting a particular tensile strength cannot be deemed mere optimization because it fails to take into consideration that the objective is not merely to provide increased tensile strength but, at the very same time, to retain the optical properties that generate iridescence. Any similarity between a multilayer film and a single layer film ends when attempting an orientation process with a structure which contains multiple layers made of different polymers which alternate to generate the iridescent optical effect. The inherent rheological and thermomechanical properties of the individual polymers dictate a completely different set of process conditions that implemented for a traditional monolayer terephthalate film such as that in Akamatsu. Unexpectedly, the “optimal” range deviates from the preferred range for any of the individual polymers. To indicate that selecting a tensile strength merely constitutes optimization requires employment of an “obvious to try” standard and that is not permissible.

Withdrawal of the prior rejection based on the combination of Shetty and Akamatsu is a recognition that the combination is insufficient to render the claimed invention obvious. The newly cited Onderkirk do not cure that insufficiency.

Onderkirk reference has been cited to show uniaxial orientation. The fact that uniaxial orientation exists, which is respectfully submitted to be the sole relevant teaching

of Onderkirk, does not suggest its use in the present invention. Claim 14 of Onderkirk to which the Office Action refers calls for providing a uniaxially oriented first resin and then incorporating a second resin as a disperse phase within a matrix of the first resin. The orientation, whether it be the uniaxial as in claim 14 of Onderkirk or biaxial as in claim 15, is for the purpose of imparting birefringence, i.e., altering the optical effect. In the present invention, however, the purpose of orientation is to augment the mechanical properties without altering the optical effect. Clearly, one skilled in the art would not look to Onderkirk for a suggestion of uniaxially orientating a film without altering the optical effect since the reference teaches the opposite result will result.

In light of the foregoing considerations, it is respectfully submitted that the rejection under 35 USC 103 should be withdrawn and the application allowed. Accordingly, the early issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,



Edward A. Meilman
Registration No.: 24,735
Stephen A. Soffen
Registration No.: 31,063
DICKSTEIN SHAPIRO MORIN & OSHINSKY, LLP
1177 Avenue of the Americas
New York, New York 10036
Telephone: (212) 835-1400

EAM/SAS:hg